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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,950	09/30/2005	Timothy P. Tully	17VV-137227	1059

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EXAMINER

DUTT, ADITI

ART UNIT	PAPER NUMBER
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1649

MAIL DATE	DELIVERY MODE
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01/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/527,950	Applicant(s) TULLY ET AL.	
	Examiner Aditi Dutt	Art Unit 1649	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation below. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-4, 6-10, 12-15, 19-22 and 24.
 Claim(s) withdrawn from consideration: 17, 18 and 25.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See explanation below.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Jeffrey Stucker/
Supervisory Patent Examiner, Art Unit 1649

/A. D./
Examiner, Art Unit 1649

Continuation of 11

Does not place the application for condition of allowance because:

103(a)

1) The rejections of claims 1, 3-7, 9-12, 14 and 16 as obvious over Sheriff et al in view of Herzog et al. are maintained as Applicant's arguments have not been found to be persuasive. Applicant traverses the rejection alleging that Sheriff et al do not "characterize the results" the way "the Examiner's own improper independent analysis of the data" is presented. Specifically Applicant asserts that contrary to Examiner's assertion, Sheriff teaches that forskolin and NPY increase luciferase activity, and that this "may involve more than one member of CRE binding transcription factors". Additionally, Applicants allege that Examiner's conclusion that because CREB and NPY have known cognitive modulatory effects, "screening compounds for such function" is obvious and a motivation to the person of ordinary skill, is absolutely "ungrounded" and "simply impermissible". Also, Applicants continue to argue that Sheriff does "not teach or suggest screening a plurality of compounds for potential development as candidate cognitive enhancer compounds". Applicant further argues that Examiner's proposition on "hindsight reasoning" is "inapposite to the present facts", because Examiner has not identified any reason for the teaching of "a plurality of test compounds" in the prior art. Furthermore, Applicant alleges that the Examiner's comments on this limitation being in the preamble, and that testing a plurality of test compounds is required by screening, supports that the references do not "support a prima facie case of obviousness".

Applicant's arguments are fully considered, however, are not found to be persuasive. As stated in the previous Office Action, it is argued that Sheriff et al. demonstrate that the luciferase activity in control cells treated with NPY but not with forskolin is not significantly different from the activity elicited by control cells that are not treated with either forskolin or with NPY (Figure 5, 1st and 2nd bar). Additionally, the treatment of the transfected cells with NPY and forskolin results in a significant increase of luciferase activity as compared to control cells treated with forskolin but not with the NPY (Abstract; Results: Section 3.5; Figure 5, 5th and 6th bar). Applicant's allegation that Sheriff's teaching is contrary to Examiner's interpretation is mistaken because of comparable observations matching the requirements in the claimed method as shown in Figure 5. Furthermore, Sheriff's analysis of data showing that both forskolin and NPY increased luciferase activity is in reference to Figure 4A (see page 313, col 2, para 2). Figure 4A does not fully represent the claimed invention because it does not have the experimental group demonstrating the indicator activity in the presence of both forskolin and NPY. Moreover, The claims do not require that the test substance is not involving more than one member of CRE binding transcription factors, thus Applicant's arguments emphasizing this reasoning is irrelevant. Furthermore, it is reiterated that because CREB and NPY are important regulators in cognitive function and because the combined references teach that NPY stimulates the CREB pathway, a person of ordinary skill would be motivated to test for enhancer compounds like NPY.

Also, it is reiterated that "screening a plurality of compounds" is part of the preamble of the claim reciting the screening method that reflects a general feature of any screening protocol without providing further limitations to the invention. Additionally, screening implies testing more than one compound. Therefore, the addition of the limitation "plurality of compounds" does not add any distinct limitation to the claimed method, rather is redundant. Because the combined references teach the inventive method steps for reasons explained above, there is no requirement that an "express, written motivation to combine must appear in prior art references before a finding of obviousness." See Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). **>See MPEP § 2141 and § 2143 for guidance regarding establishment of a prima facie case of obviousness. Thus, contrary to Applicant's contention, a proper prima facie case of obviousness was established and the claimed invention stand rejected over the combined teachings of the prior art.

2) The rejections of claims 19(a-k), and 20-24 as obvious over Sheriff et al in view of Herzog et al. and further in view of Barad et al. are maintained as Applicant's arguments have not been found to be persuasive.

Applicant maintains the prior arguments stating that neither Sheriff nor Herzog teaches or suggests screening a plurality of compounds to determine the ability of compounds to enhance the CREB pathway and identify the compounds as a candidate cognitive enhancer compound based on the claimed invention, nor does Barad remedy the deficiencies.

Applicant's arguments are fully considered but not found to be persuasive for reasons explained above As stated in the previous Office Action it is reiterated that it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method for elevating Y1 message in neuroblastoma cells as taught by Sheriff et al., by using hippocampal neurons, or hippocampal slices as taught by Barad et al., and be motivated to do so because neurons are individual cells that would elicit the CREB dependent gene expression in a cell specific manner.

3) 2) The rejections of claims 2, 8 and 13 as obvious over Sheriff et al in view of Herzog et al. and further in view of Barad et al. are maintained.

Applicant maintains the same argument as stated in the previous response that neither Sheriff nor Herzog teaches or suggests screening a plurality of compounds to determine the ability of compounds to enhance the CREB pathway and identify the compounds as a candidate cognitive enhancer compound based on the claimed invention, nor does Barad remedy the deficiencies. Applicant's arguments have not been found to be persuasive for reasons explained above.

Claim objection

Following claims are objected:

Claim 1: has a typo in step 'c)' line 1, that recites "...determined in step c)" instead of "b)".

Claim 19: is amended (see step '1)', line 1. Thus the status of the claim should state "Currently Amended".

Claim 24: depends from a cancelled claim 23.